THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD

In re: LABCAST
Application Serial No.: 75/813380
Current Applicant: Varian, Inc. (Prior Applicant: VanKel Technology Group)

Opposition No. 91150161

Innovative Programming Associates, Inc.

Opposer

v.

Varian, Inc.

Applicant

APPLICANT'S MOTION TO STRIKE OPPOSER'S AFFIRMATIVE DEFENSES

I. Introduction

Applicant Varian, Inc. ("Applicant") hereby moves to strike each of the three Affirmative Defenses set forth in the Answer to Applicant's Counterclaim filed by Opposer Innovative Programming Associates, Inc. ("Opposer") mailed and served on December 21, 2001. This motion is brought under FRCP 12(f). It is well established that under FRCP 12(f), the Board may order stricken from a pleading "any insufficient defense or any redundant, immaterial, impertinent or scandalous matter".

II. Grounds For Striking Opposer's Third Affirmative Defense

In Affirmative Defense No. 3, Opposer states that it "...believes that Applicant's course of action... are such violations of the Lanham Act (15 U.S.C. 1051 et seq.) and of Opposer's rights of

registrant of a mark under Section 35 of the Lanham Act as to warranty [sic] a finding of reasonable costs for Opposer and such costs are respectfully requested."

This allegation should be stricken because the Board does not have authority to hold any person in contempt, or to award attorneys' fees, other expenses, or damages to any party. *See generally* 37 CFR §§2.120(f). *See also Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237 (TTAB 1993).

III. Grounds For Striking Opposer's Second Affirmative Defense

In Affirmative Defense No. 2, Opposer has alleged that "Applicant's Answer to Notice of Opposition and Counterclaim to Restrict Opposer's Registration fails to state a claim upon which relief can be granted." This Affirmative Defense must be stricken because it is clear that Applicant's counterclaim does state a claim upon which relief can be granted and Opposer has presented absolutely no facts which lead to any other conclusion.

As stated by the Board in *Order Sons of Italy in America v. Marofa S.A.*, 38 USPQ2d 1602 (TTAB 1996):

> the striking of the defense that a complaint fails to state a claim upon which relief could be granted may be appropriate when the legal insufficiency of this defense is readily apparent. See Wright & Miller, Federal Practice and Procedure: Civil 2d Section 1381 (1990). As stated by the Board in *S.C. Johnson & Son, Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973):
> [w]hile Rule 12(b)(6) permits a defendant to assert in his answer the "defense" of failure to state a claim upon which relief can be granted, it necessarily follows that the plaintiff may utilize this assertion to test the sufficiency of the plaintiff's pleading in advance of trial by moving under Rule 12(f) . . . to strike the "defense" from the defendant's answer. In the present case, wherein the pleadings are similar to those of opposer in *Order Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221 (TTAB 1995), the Board finds, as it did there, that opposer has set forth sufficient allegations to establish, if proven, that opposer has standing to bring this proceeding and to support a pleading of disparagement, contempt, and/or disrepute under Section 2(a) of the Trademark Act. Accordingly, opposer's pleadings clearly allege a legally sufficient claim and applicant's

defense of failure to state a claim upon which relief may be granted must fall as a legally insufficient defense.

The pleadings of the instant case are identical to the circumstances of *Order Sons of Itay, supra,* and Opposer's second affirmative defense should be stricken.

IV. Grounds For Striking Opposer's First Affirmative Defense

In Affirmative Defense No. 1, Opposer alleges that "Opposer is entitled to the full ownership rights in this mark granted under the Lanham Act (15 U.S.C. 1051 et seq.) as legitimate owner of the Trademark U.S. Registration No. 1,284,179 for LABCAT." This affirmative defense should be stricken because it merely reiterates Opposer's claims of rights in its mark, without setting forth a true affirmative defense, such as, for example, estoppel or unclean hands. These allegations are therefore redundant and should be stricken. *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221 (TTAB 1995).

V. Conclusion

For the foregoing reasons, each of the affirmative defenses set forth in Opposer's Answer to Applicant's Counterclaim should be stricken.

Respectfully submitted,

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CERTIFICATE OF MAILING

I certify that this document is being deposited with the United States Postal Service, First Class postage pre-paid, addressed to Commissioner of Trademarks, Attn: TTAB, 2900 Crystal Drive, Arlington, VA 22202-3513 on January 3, 2002.

Dated: Jan 3, 2002

Roy S. Gordet

CERTIFICATE OF SERVICE

I certify that I served a copy of this document on Opposer by mailing it with the United States Postal Service, First Class postage pre-paid, addressed as follows:
Charles F. Manero, Woodbridge & Associates, P.O. Box 592, Princeton, NJ 08542-0592 on January 3, 2002.

Dated: Jan 3, 2002

Roy S. Gordet